

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

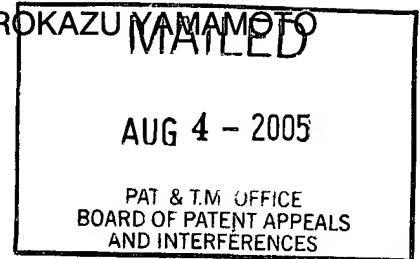
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte TOSHIRO NISHI, NOBUAKI MURAKAMI, and HIROKAZU YAMAMOTO

Appeal No. 2005-0662
Application No. 09/118,833

HEARD: July 14, 2005



Before WARREN, KRATZ, and TIMM, *Administrative Patent Judges*.
TIMM, *Administrative Patent Judge*.

REMANDED TO THE EXAMINER

A review of the record presently before us leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we remand the application to the Examiner, via the Office of a Director of the involved Technology Center, to consider the following issues and to take action not inconsistent with the views expressed herein.

The Examiner maintains only one rejection on appeal, the rejection of claims 4-30 under 35 U.S.C. § 103(a) over JP 08-050913 (JP 913) in view of US 5,411,767 (Soma). With regard to the Japanese document, the Examiner relies upon a translation generated by computer.

In order to properly review the rejection, it is of the utmost importance to have an English translation that reflects what is said in the original foreign document. Without such a translation, we cannot determine whether the underlying evidence supports the rejection. The computer generated translation falls short. An accurate English translation that reflects the full disclosure of the original Japanese document is required before we can review the rejection on appeal.

The Examiner may also wish to re-evaluate the withdrawal of the rejections over Soma alone. The question is: Is it reasonable to believe that the Soma battery has the structure required by any of the claims, particularly the "sintered interconnector" or "co-sintered interconnector" structure, such that the burden can properly be shifted to the applicant to prove that the structure is indeed patentably distinct? *In re Best*, 562 F.2d 1252, 1254-55, 195 USPQ 430, 432-34 (CCPA 1977). We note that the claim does not limit the degree of sintering. Nor is there any particular level of fusion or densification required by the claims. In comparison, fusion and densification appear to occur in the process of Soma during both thermal spraying and heating. If it is reasonable to shift the burden, the declaratory evidence of record must be reviewed to determine if Appellants have proven that there is a patentable difference in structure. We note in this regard that the Nishi Declarations of record do not indicate that a heating step according to Soma was performed on plasma sprayed material (A), the comparative material, nor is it clear that what is shown in SEM photomicrograph (B) is commensurate-in-scope with the claims.

Appellants must at least compare the prior art structure of the reference with structures commensurate-in-scope with the claim for the showing to be sufficiently probative.

CONCLUSION

In summary, the instant application is remanded to the Examiner to consider the aforementioned issues and to act accordingly.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

Paula J. Brown

Pete F. Kunt

Catherine Timm
CATHERINE TIMM

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Birch, Stewart, Kolasch & Birch
P. O. Box 747
Falls Church, VA 22040-0747